06-12-03

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June 9, 2003

Mail Stop Appeal Brief - Patents
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Re:	Application Serial No.:	09/972,400
	Confirmation No.:	5065
	Applicants:	Jay Paul Drummond, et al.
	Title:	Automated Banking Machine and System
	Docket No.:	D-1077+14 DIV

Sir:

Please find enclosed the Brief of Appellants pursuant to 37 C.F.R. § 1.192 in triplicate for filing in the above-referenced application.

It is believed that no extension of time is required. However, if such an extension is required then please consider this a petition therefore.

Please charge the fee required with this filing ($320) and any other fee due to Deposit Account 09-0428.

Very truly yours,

Ralph E. Jocke
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D-1077+14 DIV

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re Application of:)
      Jay Paul Drummond, et al.)
)
Serial No.: **09/972,400**)   Art Unit 3628
)
Confirm. No.: **5065**)
)   Patent Examiner
Filed: **October 5, 2001**)   Pedro R. Kanof
)
Title: **Automated Banking Machine**)
      and System)

Mail Stop Appeal Brief - Patents
Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

BRIEF OF APPELLANTS PURSUANT TO 37 C.F.R. § 1.192

Sir:

The Appellants hereby submit their Appeal Brief pursuant to 37 C.F.R. § 1.192, in

triplicate, concerning the above-referenced Application.

REAL PARTY IN INTEREST

The Assignee of all right, title and interest to the above-referenced Application is

Diebold, Incorporated, an Ohio corporation.

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RELATED APPEALS AND INTERFERENCES

Appellants believe that there are no related appeals or interferences pertaining to this matter.

STATUS OF CLAIMS

Claims 1-26 are pending in the Application.

Claims 1-26 were rejected under 35 U.S.C. § 103(a) in view of Wagner (U.S. Patent 5,742,845).

These rejections were the only rejections present in the Office Action ("Action") dated February 19, 2003. Appellants appeal the rejection of claims 1 through 26, inclusive.

STATUS OF AMENDMENTS

No final rejection has been made. However, claims have been twice rejected. Therefore, no amendments to the claims were requested to be admitted after a final rejection.

SUMMARY OF INVENTION

Overview of the Invention

An exemplary form of the invention is directed to method and apparatus including an automated teller machine (ATM) (12). The ATM includes a computer (34) and transaction function devices (36), e.g., printer (46) and cash dispenser (42).

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A transaction record (104) is stored in memory as data in an object in software. The object is used to accumulate data as an ATM transaction proceeds. The data stored in the transaction data object (104) may include data input through input devices (38, 40) by the ATM customer as well as data representative of operations carried out by transaction function devices.

Computer software that operates in the ATM includes a browser (76) that is operative to access HTML documents through a server (88). The browser (76) can process the accessed HTML documents. The HTML documents can include instructions adapted to cause operation of the transaction function devices in the ATM. For example, an HTML document may include a cash dispense instruction adapted to cause operation of the cash dispenser (42) (Specification page 34, lines 17-21). For further example, an HTML document may include a print instruction causing the printer (46) to print a customer's transaction receipt. The software which controls receipt printing can obtain the data used in printing the receipt from the transaction data stored in the transaction data object or record (104). Thus, the software can cause the printer to print a receipt responsive to the print instruction included in the accessed HTML document and the stored transaction data.

The operation of the exemplary software components enables selectively accessing HTM documents which produce different formats for printed items as well as using instructions contained in the HTML documents to include transaction data within the printed items. This enables printing items of varied types. For example, the arrangement may be used for printing receipts as well as for printing customer account statements and for printing a transaction journal within the ATM. The exemplary printing method also enables the printing of other various

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items, such as checks, wagering slips, coupons, marketing information, scrip, and travelers checks. The ATM can print a first item responsive to a print instruction in a first HTML document and print a second item responsive to a print instruction in a second HTML document.

Furthermore, different types of documents can be printed for different customers. For example, the arrangement enables providing printed formats in various languages (e.g., English) by using HTML documents which can provide printed forms in different languages. Thus, a first printed item can be of a first language and a second printed item can be of a second language.

Further description of an exemplary embodiment may be found at Specification page 73, line 11 through page 77, line 7, and Figure 31.

CONCISE STATEMENT OF THE ISSUES PRESENTED FOR REVIEW

The questions presented in this appeal are:

1).   Whether Appellants' claims 1-26 are unpatentable under 35 U.S.C. § 103(a) over Wagner.

GROUPING OF CLAIMS

No groups of claims stand or fall together. Every claim recites additional features of the invention which distinguishes the claim over every other pending claim.

Each of Appellants' claims recites at least one element, combination of elements, or step not found or suggested in the applied references, which patentably distinguishes the claims.

The pending claims include eight independent claims (claims 1, 6, 14-15, 17-18, 21, and

25). Claims 2-5 and 8-13 depend from claim 1. Claim 7 depends from claim 6. Claim 16

depends from claim 15. Claims 19-20 depend from claim 14. Claims 22-24 depend from claim

21. Claim 26 depends from claim 25. All pending claims 1-26 are reproduced in the Appendix.

ARGUMENT

The Applicable Legal Standards

Before a claim may be rejected on the basis of obviousness pursuant to 35 U.S.C. § 103,

the Patent Office bears the burden of establishing that all the recited features of the claim are

known in the prior art. This is known as *prima facie* obviousness. To establish *prima facie*

obviousness, it must be shown that all the elements and relationships recited in the claim are

known in the prior art. If the Office does not produce a *prima facie* case, then the Appellants are

under no obligation to submit evidence of nonobviousness. MPEP § 2142.

The teaching, suggestion, or motivation to combine the features in prior art references

must be clearly and particularly identified in such prior art to support a rejection on the basis of

obviousness. It is not sufficient to offer a broad range of sources and make conclusory

statements. *In re Dembiczak*, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999).

Even if all of the features recited in the claim are known in the prior art, it is still not proper

to reject a claim on the basis of obviousness unless there is a specific teaching, suggestion, or

motivation in the prior art to produce the claimed combination. *Panduit Corp. v. Denison Mfg.*

Co., 810 F.2d 1561, 1568, 1 USPQ2d 1593 (Fed. Cir. 1987). *In re Newell*, 891 F.2d 899, 901, 902, 13 USPQ2d 1248, 1250 (Fed. Cir. 1989).

The evidence of record must teach or suggest the recited features. An assertion of basic knowledge and common sense not based on any evidence in the record lacks substantial evidence support. *In re Zurko*, 258 F.3d 1379, 59 USPQ2d 1693 (Fed. Cir. 2001).

A determination of patentability must be based on evidence of record. *In re Lee*, 277 F.3d 1338, 61 USPQ2d 1430 (Fed. Cir. 2002).

It is respectfully submitted that the Action from which this appeal is taken does not meet these burdens.

The Wagner Reference

Wagner is directed to a system for extending present open network communication protocols to communicate with non-standard I/O devices coupled to an open network. The system (10) includes a Web server (12) which is coupled to an open network (14) such as the Internet for communication with various non-standard I/O devices (16, 18, 20, 32, 34, 36, 38) (Figure 1; col. 9, line 63 to col. 10, line 1). The system permits a consumer to collect product information by using an open network, such as the Internet, and then use a more secure transaction link for the transaction (col. 6, lines 12-16; col. 18, lines 26-36). A client program executes in a non-standard I/O device (col. 10, lines 52-54). For a payment transaction the client program is suspended and control is transferred to a conventional bank processing application.

Thus, the system can maintain usage of a conventional secure proprietary transaction system for authorization and settlement (col. 11, lines 58-65).

The system permits a user to use the open network for non-confidential communication such as collecting product information, pricing, and product availability. This information may be collected quickly and efficiently using the extended Internet protocol. The conventional bank processing program and more secure communication links may then be used for the confidential information required to carry out the transaction. Thus, Wagner seeks to combine the features and advantages of the Internet with the more secure communication link and data security enhancing devices of systems presently known (col. 7, lines 15-25).

(iv)   35 U.S.C. § 103

Appellants traverse the rejections on the grounds that Appellants' claims recite features, relationships, and/or steps which are neither disclosed nor suggested in the prior art, and because there is no teaching, suggestion, or motivation cited so as to produce Appellants' invention. The features, relationships, and/or steps recited in Appellants' claims patentably distinguish over the applied Wagner reference. Nor would it have been obvious to one having ordinary skill in the art to have combined the teachings of Wagner to have produced the recited invention.

The Office does not factually support any *prima facie* conclusion of obviousness. To establish *prima facie* obviousness, the prior art must teach or suggest all the claim limitations. If the Office does not produce a *prima facie* case, which is the current situation, then the Appellants

are under no obligation to submit evidence of nonobviousness (MPEP § 2142). The Office has not established a *prima facie* showing of obviousness.

The Appellants respectfully disagree with the Action's interpretation of the Wagner reference. Even if it were somehow possible (which it isn't) for the Action to show (which it doesn't) that all of the recited features were known in the prior art, it is still not proper to reject a claim on the basis of obviousness unless there is a specific teaching, suggestion, or motivation in the prior art to produce the claimed combination. *Panduit Corp. v. Denison Mfg. Co.*, supra. *In re Newell*, supra. The Action does not provide any teaching, suggestion, or motivation in the prior art to modify the Wagner reference. Thus, it would not have been obvious to one having ordinary skill in the art to have modified Wagner to have produced Appellants' claimed invention.

Nor does the Action explain how Wagner could be modified. Since the Action does not explain the rejections with reasonable specificity, it also procedurally fails to establish a *prima facie* case of obviousness. *Ex parte Blanc*, 13 USPQ2d 1383 (Bd. Pat. App. & Inter. 1989).

The Appellants respectfully submit that the attempts to combine teachings are clearly attempts at hindsight reconstruction of Appellants' claimed invention, which is legally impermissible and does not constitute a valid basis for a finding of obviousness. *In re Fritch*, 22 USPQ2d 1780 (Fed. Cir. 1992). The rejections, which lack the necessary evidence and rationale, are based on knowledge gleaned only from Appellants' disclosure. It follows that it would not have been obvious to have modified the Wagner reference in the manner alleged. Furthermore,

without any prior art showing of a motivation to combine, which is the current situation, a rejection based on a *prima facie* case of obviousness is improper (MPEP § 2143.01).

Thus, it is respectfully submitted that the 35 U.S.C. § 103(a) rejections are improper and should be withdrawn.

The Pending Claims Are Not Obvious Over
Wagner

In the Action claims 1-26 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Wagner. These rejections are respectfully traversed.

Claim 1

The Appellants respectfully disagree with the Action's interpretation of Wagner. The Action's cited sections of Wagner do not teach or suggest the features and relationships specifically recited in claim 1.

Wagner discloses that central transaction processing systems are typically coupled to (standard) transaction computers, such as automatic teller machines (ATMs) (col. 1, lines 22-26). The coupling can occur in many secure ways, including dedicated lines or a PSTN network (col. 1, line 58 to col. 2, line 8). Wagner teaches that a computer, such as a personal computer (PC), is a standard I/O device (col. 9, lines 62-63). A PC can perform standard input/output (I/O) operations because it has a standard monitor screen, a standard keyboard, and standard peripherals (col. 3, lines 56-62).

In Wagner, non-standard I/O devices are devices which interface or couple to a computer (e.g., PC) through a port not normally used for networks, such as an RS-232C interface (col. 4, lines 4-9; col. 10, lines 5-6). These non-standard I/O devices only use communication interfaces such as RS-232C (col. 3, lines 62-64). Wagner defines non-standard I/O devices as a screen phone terminal (16), personal digital assistant (18), credit card terminal (20), smart card reader (32), PIN pad (34), magnetic card swipe reader (36), and a printer (38) (Figure 1; col. 9, line 63 to col. 10, line 1).

The Appellants respectfully disagree with the allegation in the Action that an automated banking machine is a non-standard I/O device. As previously discussed, Wagner distinguishes standard I/O devices from non-standard I/O devices. Wagner does not teach or suggest that a non-standard I/O device includes an automated banking machine. Rather, Wagner teaches away from an automated banking machine being a non-standard I/O device, especially with an ATM already having a (standard) transaction computer.

Furthermore, nowhere does Wagner teach or suggest that an automated banking machine, such as an ATM, can communicate via the Internet through protocols such as HTTP and markup language documents (e.g., HTML documents). Rather, Wagner teaches a system directed to extending open network communication protocols and data message formats to communicate with non-standard I/O devices (col. 5, lines 47-51). Even the Action (page 4, line 1) admits that the alleged transaction machine in Wagner does not constitute an automated banking machine.

Wagner also does not teach or suggest a method that includes accessing a markup language document with a browser operating in an automated banking machine computer. Nor

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does Wagner teach or suggest a method of printing transaction data with a printer in an automated banking machine.

Nor would it have been obvious to have included an automated banking machine in Wagner in the manner alleged. Wagner' server appears to at best communicate with remote stand-alone non-standard I/O devices that lack a transaction computer. Wagner does not teach or suggest bypassing the computer in an ATM to directly communicate with the ATM devices. What purpose would an ATM computer serve in the alleged modification? Wagner does not teach or suggest an ATM having a non-standard I/O device, and separately communicating with the non-standard I/O device while bypassing the ATM computer. Wagner does not teach or suggest separately and directly communicating with a non-standard I/O device of an ATM that is already controlled by the ATM computer. The Action admits that Wagner does not teach that an ATM is a non-standard I/O device. Nothing in Wagner discloses or suggests substituting an ATM for a non-standard I/O device of Wagner (and there would be no purpose to be served by doing so). The assertions in the Action are clearly attempts at impermissible hindsight reconstruction.

The Action is also silent as to how the structure of Wagner could be modified with an automated banking machine to include the features, relationships, and steps recited in claim 1. The alleged modification to Wagner would destroy the disclosed and desired utility or operability of the Wagner teaching. An obviousness rejection cannot be based on a combination of features if making the combination would result in destroying the utility or advantage of the device shown in the prior art reference. *In re Fine*, 5 USPQ2d 1598-99 (Fed. Cir. 1988). Therefore, it would

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not have been obvious to have modified Wagner as alleged to have produced the recited invention.

It would not have been obvious to have modified Wagner to have produced the recited invention. The Action is devoid of any such teaching, suggestion, or motivation for combining features of the reference to have produced the recited invention.

Wagner also does not teach or suggest many other recited features, relationships, and steps. For example, the Action alleges that Wagner has a "transaction machine" (yet admits that Wagner lacks an automated banking machine). However, the Action is silent as to what structure in Wagner constitutes this alleged transaction machine. Claim 1 is directed to a "method of printing a document with an automated banking machine" and recites that the printing is carried out "with a printer in the machine." Where does Wagner teach or suggest a banking machine with a printer therein? Even if Wagner somehow had a banking machine with a printer (e.g., printer 38) therein, Wagner would still not teach or suggest that the printer would print indicia responsive to a print instruction included in a markup language document, especially where the indicia corresponds to transaction data stored in memory. Furthermore, it is unclear how Wagner's printer (38) could conduct a transaction (step a). It follows that Wagner's printer (38) cannot constitute the recited automated banking machine.

Although Wagner discloses a "TO PRINTER METHOD" in a file (510, 555) (Figures 14, 15B), such a file does not correspond to the method steps recited in claim 1. For example, as shown in all of the examples of a "TO PRINTER METHOD" (Figures 14, 15B, 16B,17A, 17B, 18, 19, 20, 21 and 22) the information supplied in the file (the numbers with multiple 9s) is static

information, embedded by the server (12) within the file (510, 555) prior to being received by the non-standard I/O devices (col. 5, lines 58-64; col. 19, lines 19-22). Nowhere does Wagner teach or suggest that transaction information (corresponding to a transaction conducted with an automated banking machine) that has been stored in memory associated with a computer (which is associated with that machine) is printed out responsive to a print instruction that is included in a markup language document accessed with a browser operating in that computer.

Furthermore, Wagner's printer (38) is directed to printing a purchase agreement form (e.g., charge slip) for the customer's signature (col. 18, lines 33-36; col. 19, lines 27-28; col. 5, lines 3-8) in order to permit a transaction to occur. It is unclear how Wagner's printer (38) could print transaction data indicia prior to the transaction data being stored in memory (after the customer's signature of the printed agreement form)? That is, how can Wagner print data pertaining to the transaction prior to the transaction being carried out?

As previously discussed (and the Action admits), Wagner does not teach or suggest an automated banking machine. Wagner is the only teaching relied on in the Action. Thus, the Office has not met the burden of establishing that all the recited features of Appellants' claim 1 are known in the prior art. To present a valid rejection, the evidence of record must teach or suggest the recited features. *In re Zurko*, supra. However, by the Office's own admission, the evidence of record (i.e., Wagner) does not teach or suggest the recited features. It follows that Wagner cannot teach or suggest any of the recited steps.

The Action asserts that Wagner discloses storing transaction data corresponding to a transaction in a memory in operative connection with a computer of a transaction machine (col.

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10, lines 10-25; col. 17, lines 48-58). The Appellants respectively disagree that the relied upon sections of Wagner teach or suggest the features and relationships recited step (b) of claim 1. Where does Wagner teach or suggest conducting a transaction with an automated banking machine (step a)? Where does Wagner teach or suggest storing transaction data corresponding to the step (a) transaction with a computer associated with the step (a) machine? Where does Wagner teach or suggest storing transaction data in a memory in operative connection with a computer? Where does Wagner teach or suggest "storing" any transaction data in a memory?

Wagner does not teach or suggest the features and relationships recited in the claim. Where does Wagner teach or suggest accessing a first markup language document with a browser operating in the computer of step (b), especially where the first markup language document includes a print instruction? Where does Wagner teach or suggest a browser operating in the same computer which is associated with both the machine and the stored transaction data? Where does Wagner even mention a browser? Nor is a browser necessarily present in Wagner. Wagner does not teach or suggest step (c).

Wagner also does not teach or suggest the features and relationships recited in step (d). Wagner does not teach or suggest that indicia corresponding to stored transaction data is printed with a printer in an automated banking machine. Particularly Wagner does not teach or suggest that such indicia is printed in response to a print instruction included in a markup language document, nor that such a document is accessed by a browser in a computer being operatively connected with the memory which stores the transaction data, nor that such transaction data

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corresponds to a transaction conducted with the automated banking machine. Again, Wagner does not teach or suggest the relationships of the features in the recited steps.

There is no linking relationship disclosed or suggested in Wagner between an automated banking machine, transaction data, memory, computer, markup language document, browser, print instruction, indicia, and printer as is specifically recited in claim 1. It follows that Wagner does not teach or suggest the recited steps. The attempts to modify Wagner are clearly attempts at hindsight reconstruction of Appellants' claimed invention, which is legally impermissible and does not constitute a valid basis for a finding of obviousness. *In re Fritch*, 22 USPQ2d 1780 (Fed. Cir. 1992). The rejection, which lacks the necessary evidence and rationale, is based on knowledge gleaned only from Appellants' disclosure.

As nothing in the applied art teaches nor suggests the features and relationships that are specifically recited in the claim, and because there is no teaching, suggestion, or motivation cited for combining features of the cited Wagner reference so as to produce Appellants' recited invention, it is respectfully submitted that claim 1 is allowable.

The Office does not factually support any *prima facie* conclusion of obviousness. Wagner does not teach or suggest the recited features, relationships, and steps. Nor would it have been obvious to one having ordinary skill in the art to have modified Wagner to have produced the recited invention. Thus, it is respectfully submitted that the 35 U.S.C. § 103(a) rejection of claim 1 should be withdrawn.

Claim 2

Claim 2 depends from claim 1. Wagner further does not teach or suggest printing indicia in accordance with instructions in a markup language document which corresponds to a format. Nor has the Office established a *prima facie* showing of obviousness.

Claim 3

Claim 3 depends from claim 1. Wagner further does not teach or suggest storing transaction data including customer identifying information in memory.

Claim 4

Claim 4 depends from claim 3. Wagner further does not teach or suggest storing transaction data including customer identifying information (corresponding to indicia read by a card reader from a card) in memory. Nor has the Office established a *prima facie* showing of obviousness.

Claim 5

Claim 5 depends from claim 1. Wagner further does not teach or suggest conducting a transaction that includes the dispense of a sheet from an automated banking machine sheet dispenser. Furthermore, where does Wagner print indicia corresponding to a transaction that includes the dispense of a sheet from an automated banking machine sheet dispenser? Again, the Office has not established a *prima facie* showing of obviousness.

Claim 6

Claim 6 is an independent claim. The Appellants respectively traverse the rejection and the assertions made therein. Note Appellants' above remarks in support of the patentability of

claim 1. Wagner does not teach or suggest the recited features and relationships of the recited automated banking machine.

The Appellants respectfully submit that Wagner does not teach or suggest the recited features and relationships. For example, Wagner does not teach or suggest an automated banking machine with a cash dispenser and a computer that is operative to access a markup language document with a print instruction. In addition, Wagner does not teach or suggest software which is operative to store in a memory, transaction data corresponding to a transaction involving the cash dispenser. In addition, Wagner does not teach or suggest that such software is further operative to print indicia representative of at least a portion of the transaction data responsive to a print instruction in the markup language document and responsive to the transaction data stored in the memory.

Wagner does not teach or suggest the recited features and relationships of a computer, printer, cash dispenser, and software. For example, where does Wagner teach or suggest software operative to cause a computer to store cash dispenser transaction data in a memory? Where does Wagner teach or suggest that the software is further operative to cause the computer to access at least one markup language document including a print instruction? Where does Wagner teach or suggest that the software is further operative to cause a printer to print indicia corresponding to transaction data responsive to the print instruction and the stored transaction data?

Where does Wagner teach or suggest software that is, responsive to a markup language document print instruction and stored cash dispenser transaction data, capable of causing a

printer to print cash dispenser transaction data indicia? Where does Wagner print indicia

representative of at least one portion of data corresponding to a transaction that involves a cash

dispenser?

Furthermore, Wagner's printer (38) is directed to printing a purchase agreement form

(e.g., charge slip) for the customer's signature (col. 18, lines 33-36; col. 19, lines 27-28; col. 5,

lines 3-8) to permit a transaction to be carried out. The printer (38) is not related to a cash

dispenser, especially a cash dispenser of an automated banking machine. Nor does Wagner teach

or suggest software that is capable of causing the printer (38) to print cash dispenser transaction

data indicia, especially responsive to a print instruction included in a markup language document

and stored cash dispenser transaction data. Furthermore, how could Wagner's printer (38)

allegedly print cash dispenser transaction data indicia prior to the cash dispenser transaction data

being stored in memory (after the customer's signature of the printed agreement form)? That is,

how can Wagner print data pertaining to an alleged cash dispenser transaction, prior to the cash

dispenser operating to perform the transaction?

The Office does not factually support any *prima facie* conclusion of obviousness.

Wagner does not teach or suggest the recited features and relationships. Nor would it have been

obvious to one having ordinary skill in the art to have modified Wagner to have produced the

recited invention. Thus, it is respectfully submitted that the 35 U.S.C. § 103(a) rejection of claim

6 should be withdrawn.

Claim 7

Claim 7 depends from claim 6. Claim 7 recites that the at least one markup language document does not include the at least one portion of the transaction data. The Appellants respectfully submit that Wagner does not teach or suggest a markup language document that includes a print instruction but not transaction data. Where does Wagner teach or suggest a markup language document that includes a print instruction, yet does not include transaction data? The Office has not established a *prima facie* showing of obviousness.

Claim 8

Claim 8 depends from claim 1. Wagner further does not teach or suggest steps e, f, and g. For example, Wagner does not teach or suggest both printing indicia corresponding to stored transaction data with an automated banking machine printer responsive to a print instruction included in a first markup language document, and printing indicia corresponding to stored transaction data with the automated banking machine printer responsive to a second print instruction in a second markup language document. Where does Wagner teach or suggest using the same automated banking machine printer to print first and second indicia related to transaction data stored in memory, especially responsive to print instructions in browser-accessed first and second markup language documents? The evidence of record does not teach or suggest the recited features. *In re Zurko*, supra. Nor has the Office established a *prima facie* showing of obviousness.

Claim 9

Claim 9 depends from claim 8. Wagner further does not teach or suggest a first markup language document including indicia in a first language and a second markup language document including indicia in a second language. It follows that Wagner does not teach or suggest <u>both</u> producing a printed item with transaction indicia in a first language and producing a printed item with transaction indicia in a second language.

Claim 10

Claim 10 depends from claim 1. Wagner further does not teach or suggest a markup language document including indicia representative of machine readable indicia. Nor does Wagner teach or suggest printing an item including machine readable indicia. It follows that the Office has not established a *prima facie* showing of obviousness.

Claim 11

Claim 11 depends from claim 1. Wagner further does not teach or suggest printing indicia corresponding to transaction data with a printer that is operative to print a transaction receipt. Where does Wagner teach or suggest a printer capable of printing a receipt? Where does Wagner even mention printing a receipt? As previously discussed, Wagner's printer (38) is for printing a purchase agreement form for the customer's signature. The evidence of record does not teach or suggest the recited features. *In re Zurko*, supra. The Office has not established a *prima facie* showing of obviousness

Claim 12

Claim 12 depends from claim 1. Wagner further does not teach or suggest printing indicia corresponding to transaction data with a printer that is operative to print a check. Where does Wagner teach or suggest a printer capable of printing a check? Where does Wagner even mention printing a check? As previously discussed, Wagner's printer (38) is for printing a purchase agreement form for the customer's signature. The evidence of record does not teach or suggest the recited features. *In re Zurko*, supra. The Office has not established a *prima facie* showing of obviousness.

Claim 13

Claim 13 depends from claim 1. Wagner further does not teach or suggest printing indicia corresponding to transaction data with a printer that is operative to print a wagering slip. Where does Wagner teach or suggest a printer capable of printing a wagering slip? Where does Wagner even mention printing a wagering slip? As previously discussed, Wagner's printer (38) is for printing a purchase agreement form for the customer's signature. The evidence of record does not teach or suggest the recited features. *In re Zurko*, supra. The Office has not established a *prima facie* showing of obviousness.

Claim 14

Claim 14 is an independent claim. The Appellants respectively traverse the rejection and the assertions made therein. Note Appellants' above remarks in support of the patentability of claims 1 and 6.

The Appellants respectfully submit that Wagner does not teach or suggest the recited features and relationships. As previously discussed (and the Action admits), Wagner does not teach or suggest an automated banking machine. Wagner also does not teach or suggest the recited relationship of the transaction function devices, computer, and software. For example, where does Wagner teach or suggest software that is operative to cause a browser to access a markup language document? Where does Wagner even mention a browser? Where does Wagner teach or suggest to operate a printer to print an item responsive to a print instruction (included in a markup language document) and stored transaction data?

Furthermore, Wagner does not teach or suggest software executable in a computer of an automated banking machine, especially in which the software:

1)   includes a browser;

2)   is operative to cause the computer to store in the memory of the computer transaction data representative of at least one input to an input device;

3)   is operative to cause a browser to access a markup language document including at least one print instruction; and

4)   is operative to cause a printer of the banking machine to print an item responsive to the print instruction in a browser-accessed markup language document and the transaction data.

Although Wagner discloses a "TO PRINTER METHOD," Wagner does not teach or suggest that a non-standard I/O device, as described in the reference, includes software which is responsive to the "TO PRINTER METHOD" in the same manner as recited in claim 14. Nor

does Wagner teach or suggest printing an item responsive to <u>both</u> a print instruction in a markup language document and transaction data stored in memory by the software, especially where the transaction data is representative of input to an input device.

As discussed previously, the "TO PRINTER METHOD" of Wagner is only associated with static information received in a file from the server (12). Wagner does not teach or suggest printing an item responsive to both the "TO PRINTER METHOD" and transaction data stored in a memory, where the transaction data stored in the memory is representative of at least one input to an input device.

The Office has not established a *prima facie* showing of obviousness. Nor would it have been obvious to have modified Wagner to have produced the recited apparatus.

Claim 15

Claim 15 is an independent claim. The Appellants respectively traverse the rejection and the assertions made therein. Note Appellants' above remarks in support of the patentability of claims 1, 6, and 14. Wagner does not teach or suggest the recited features and relationships of the recited automated banking machine.

As discussed previously, Wagner does not teach or suggest software in an automated banking machine which is operative to cause a printer to print a first item responsive to both a first print instruction, included in a markup language document, and at least a portion of transaction data stored in a memory by the software which is representative of at least one input to an input device of the machine.

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In addition, Wagner does not teach or suggest that such software is operative to cause the printer to print a second item responsive to a second print instruction, included in a second markup language document, and at least a portion of the transaction data stored in the memory.

Wagner does not teach or suggest software that is operative to cause a printer to print a first item responsive to a first print instruction included in a first markup language document and transaction data, and is operative to cause the printer to print a second item responsive to a second print instruction included in a second markup language document and transaction data. As previously discussed, Wagner's printer (38) is for printing a purchase agreement form for the customer's signature (col. 18, lines 33-36; col. 19, lines 27-28; col. 5, lines 3-8) in order to permit a transaction to occur. Where does Wagner teach or suggest enabling the same printer to print first and second items related to the same transaction, especially in response to print instructions in browser-accessed first and second markup language documents?

The Office has not established a *prima facie* showing of obviousness. Nor would it have been obvious to have modified Wagner to have produced the recited apparatus

Claim 16

Claim 16 depends from claim 15. Wagner further does not teach or suggest a first markup language document including indicia in a first language and a second markup language document including indicia in a second language. It follows that Wagner does not teach or suggest both a first printed item with transaction data indicia in the first language and a second printed item with transaction data indicia in a second language. The Office has not established a *prima facie* showing of obviousness.

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Claim 17

Claim 17 is an independent claim. The Appellants respectively traverse the rejection and the assertions made therein. Note Appellants' above remarks in support of the patentability of claims 1, 6, 14, and 15. Wagner does not teach or suggest the recited features and relationships of the recited automated banking machine.

As discussed previously, Wagner does not teach or suggest an automated banking machine with software that is operative to print responsive to both a print instruction in a markup language document and transaction data.

Nowhere in Wagner is it disclosed or suggested that an automated banking machine includes software that is operative to cause a printer to print a check. Nowhere in Wagner is it disclosed or suggested that an automated banking machine includes software that is operative to cause a printer to print a check responsive to a print instruction in a markup language document and transaction data.

Wagner does not teach or suggest software that is operative to cause a printer to print a check responsive to a markup language document print instruction. Where does Wagner teach or suggest a printer capable of printing a check? Where does Wagner even mention printing a check? As previously discussed, Wagner's printer (38) is for printing a purchase agreement form for the customer's signature. The evidence of record does not teach or suggest the recited features. *In re Zurko,* supra. Nor has the Office established a *prima facie* showing of obviousness. Nor would it have been obvious to have modified Wagner to have produced the recited apparatus.

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Claim 18

Claim 18 is an independent claim. The Appellants respectively traverse the rejection and the assertions made therein. Note Appellants' above remarks in support of the patentability of claims 1, 6, 14, 15, and 17. Wagner does not teach or suggest the recited features and relationships of the recited automated banking machine.

As discussed previously, Wagner does not teach or suggest an automated banking machine with software that is operative to print responsive to both a print instruction in a markup language document and transaction data.

Further, nowhere in Wagner is it disclosed or suggested, that an automated banking machine includes software that is operative to cause a printer to print a wagering slip. Also, nowhere in Wagner is it disclosed or suggested that an automated banking machine includes software that is operative to cause a printer to print a wagering slip responsive to a print instruction in a markup language document and transaction data.

Wagner does not teach or suggest software that is operative to cause a printer to print a wagering slip responsive to a markup language document print instruction. Where does Wagner teach or suggest a printer capable of printing a wagering slip? Where does Wagner even mention printing a wagering slip? As previously discussed, Wagner's printer (38) is for printing a purchase agreement form for the customer's signature. The evidence of record does not teach or suggest the recited features. *In re Zurko*, supra. The Office has not established a *prima facie* showing of obviousness. Nor would it have been obvious to have modified Wagner to have produced the recited apparatus.

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Claim 19

Claim 19 depends from claim 14. Wagner further does not teach or suggest software that is operative to cause an automated banking machine printer to print an item responsive to a markup language document print instruction and transaction data. Nor does Wagner teach or suggest that indicia is printed on the item in accordance with format instructions in the markup language document. It follows that the Office has not established a *prima facie* showing of obviousness.

Claim 20

Claim 20 depends from claim 14. Wagner further does not teach or suggest an automated banking machine having transaction function devices including a printer, input device, and cash dispenser. Wagner also does not teach or suggest that the software is further operative to cause the cash dispenser to dispense an amount of cash. It follows that Wagner does not teach or suggest software executable in a computer of an automated banking machine, especially in which the software:

1)   includes a browser;

2)   is operative to cause the computer to store in the memory of the computer transaction data representative of at least one input to an input device;

3)   is operative to cause a browser to access a markup language document including at least one print instruction;

4) is operative to cause a printer of the machine to print an item responsive to the print instruction in a browser-accessed markup language document and the transaction data; and

5) is operative to cause the cash dispenser to dispense an amount of cash.

It follows that the Office has not established a *prima facie* showing of obviousness. Nor would it have been obvious to have modified Wagner to have produced the recited apparatus.

Claim 21

Claim 21 is an independent claim. The Appellants respectively traverse the rejection and the assertions made therein. Claim 21 is directed to computer readable media bearing instructions. The instructions are operative to cause at least one computer in an automated banking machine to cause the automated banking machine to carry out method steps, which correspond to the method steps recited in claim 1. Note Appellants' above remarks in support of the patentability of claim 1. Wagner does not teach or suggest either the steps nor computer readable media having the ability to cause an automated banking machine to perform the steps. It follows that the Office has not established a *prima facie* showing of obviousness.

Claim 22

Claim 22 depends from claim 21. Wagner further does not teach or suggest computer readable media bearing instructions which are operative to cause the at least one computer to cause an automated banking machine to perform the steps e, f, and g. For example, Wagner does not teach or suggest both printing indicia corresponding to transaction data with an automated banking machine printer responsive to a print instruction included in a first markup language

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document, and printing indicia corresponding to the transaction data with the automated banking machine printer responsive to a second print instruction in a second markup language document. Where does Wagner teach or suggest using the same automated banking machine printer to print first and second indicia related to stored transaction data, especially responsive to print instructions in browser-accessed first and second markup language documents? The evidence of record does not teach or suggest the recited features. *In re Zurko*, supra. Nor has the Office established a *prima facie* showing of obviousness.

Claim 23

Claim 23 depends from claim 21. Wagner further does not teach or suggest computer readable media bearing instructions which are operative to cause an automated banking machine to print indicia corresponding to transaction data with a printer that is operative to print a check. Where does Wagner teach or suggest a printer capable of printing a check? Where does Wagner even mention printing a check? As previously discussed, Wagner's printer (38) is for printing a purchase agreement form for the customer's signature. The evidence of record does not teach or suggest the recited features. *In re Zurko*, supra. The Office has not established a *prima facie* showing of obviousness.

Claim 24

Claim 24 depends from claim 21. Wagner further does not teach or suggest computer readable media bearing instructions which are operative to cause an automated banking machine to print indicia corresponding to transaction data with a printer that is operative to print a wagering slip. Where does Wagner teach or suggest a printer capable of printing a wagering

slip? Where does Wagner even mention printing a wagering slip? As previously discussed, Wagner's printer (38) is for printing a purchase agreement form for the customer's signature. The evidence of record does not teach or suggest the recited features. *In re Zurko*, supra. The Office has not established a *prima facie* showing of obviousness.

Claim 25

Claim 25 is an independent claim. Note Appellants' above remarks in support of the patentability of claims 1, 6, 14, 15, 17, 18, and 21. Wagner does not teach or suggest the recited method of printing a document with an automated banking machine.

The Appellants respectfully submit that Wagner does not teach or suggest conducting a transaction with an automated banking machine involving the dispense of cash with a cash dispenser. Wagner further does not teach or suggest printing (with a printer in the automated banking machine) an item corresponding to transaction data stored in memory responsive to markup language document print instruction <u>and</u> <u>the</u> transaction data stored in the memory.

Wagner does not teach or suggest storing in a memory, transaction data corresponding to a transaction involving the dispense of cash. In addition, Wagner does not teach or suggest printing indicia representative of at least a portion of the stored transaction data responsive to <u>both</u> a print instruction in the markup language document <u>and</u> the stored transaction data.

As previously discussed, Wagner's printer (38) is directed to printing a purchase agreement form for the customer's signature in order to permit a transaction to be carried out. The printer (38) is not related to a cash dispenser, especially a cash dispenser associated with an automated banking machine.

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Nor does Wagner teach or suggest operating the printer (38) to print cash dispenser transaction data indicia, especially responsive to a markup language document print instruction and stored cash dispenser transaction data. Furthermore, as previously discussed, in the theoretical modified form of Wager asserted in the Action, how could Wagner's printer (38) print cash dispenser transaction data indicia prior to the cash dispenser transaction data being stored in memory (after the customer's signature of the printed agreement form)? How can Wagner print data pertaining to a cash dispenser transaction prior to occurrence (and storage) of the cash dispenser transaction? It cannot.

The Office does not factually support any *prima facie* conclusion of obviousness. Wagner does not teach or suggest the recited features and relationships. Nor would it have been obvious to one having ordinary skill in the art to have modified Wagner to have produced the recited invention. Thus, it is respectfully submitted that the 35 U.S.C. § 103(a) rejection of claim 25 should be withdrawn.

Claim 26

Claim 26 depends from claim 25. Claim 26 recites that the at least one markup language document does not include the at least one portion of the transaction data. The Appellants respectfully submit that Wagner does not teach or suggest a markup language document that includes a print instruction but not transaction data. Where does Wagner teach or suggest a markup language document that includes a print instruction, yet does not include transaction data? The Office has not established a *prima facie* showing of obviousness.

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CONCLUSION

Each of Appellants' pending claims specifically recites features, relationships, and/or steps that are neither disclosed nor suggested in the applied art. Furthermore, the applied art is devoid of any teaching, suggestion, or motivation for combining features of the applied art so as to produce the recited invention. For these reasons it is respectfully submitted that all the pending claims are allowable.

Respectfully submitted,

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APPENDIX

CLAIMS

1.   A method of printing a document with an automated banking machine, comprising the steps of:

        (a)   conducting at least one transaction with the machine;

        (b)   storing transaction data corresponding to the transaction in a memory in operative connection with a computer, wherein the computer is operatively connected with the machine;

        (c)   accessing a first markup language document with a browser operating in the computer, wherein the first markup language document includes at least one print instruction; and

        (d)   printing indicia corresponding to the transaction data in the memory with a printer in the machine responsive to the print instruction included in the first document.

2.   The method according to claim 1 wherein the first markup language document includes instructions therein corresponding to a format, and wherein in step (d) the indicia is printed in accordance with the format.

3.   The method according to claim 1 and further comprising the step of:

inputting customer identifying information to the machine, wherein data corresponding to the customer identifying information is included in the transaction data stored in the storing step.

4.   The method according to claim 3 wherein the inputting step includes inputting a card into a card reader on the machine, wherein the customer identifying information corresponds to indicia read by the card reader from the card.

5.   The method according to claim 1 wherein the transaction conducted in step (a) includes the dispense of at least one sheet from a sheet dispenser in the machine.

6.   An automated banking machine comprising:

a computer in operative connection with a memory;

a printer in operative connection with the computer;

a cash dispenser in operative connection with the computer; and

software executable in the computer, wherein the software is operative:

to cause the computer to store transaction data corresponding to a
transaction involving the cash dispenser in the memory;

to cause the computer to access at least one markup language document,
wherein the at least one markup language document includes at least one
print instruction; and

to cause the printer to print at least one item which includes indicia
representative of at least one portion of the transaction data responsive to
the print instruction and the transaction data stored in the memory.

7.   An automated banking machine according to claim 6, wherein the at least one markup
language document does not include the at least one portion of the transaction data.

8.   The method according to claim 1 and further comprising the steps of:

e) providing a plurality of markup language documents accessible through a server, said documents including the first document, and a second document wherein the second document includes at least one second print instruction;

f) accessing the second markup language document with the browser;

g) printing indicia corresponding to the transaction data in memory with the printer in the machine responsive to the second print instruction included in the second document.

9. The method according to claim 8 wherein the first document includes indicia in a first language and the second document includes indicia in a second language, and wherein in step (d) a printed item including transaction indicia is produced in a first language and in step (g) a printed item is produced including transaction indicia in a second language.

10. The method according to claim 1 wherein the first document includes indicia representative of machine readable indicia, wherein in step (d) a printed item is produced including machine readable indicia.

11. The method according to claim 1 wherein in step (d) the printer is operative to print a transaction receipt.

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12.   The method according to claim 1 wherein in step (d) the printer is operative to print a check.

13.   The method according to claim 1 wherein in step (d) the printer is operative to print a wagering slip.

14.   An automated banking machine including:

a plurality of transaction function devices, the transaction function devices including a printer and an input device;

a computer in operative connection with the transaction function devices and a memory, wherein the computer includes software executable therein, wherein the software includes a browser;

wherein the software is operative to cause the computer to store in the memory transaction data representative of at least one input to an input device, and wherein the software is operative to cause the browser to access a markup language document including at least one print instruction and to operate the printer to print an item responsive to the print instruction and the transaction data.

15.   An automated banking machine including:

a plurality of transaction function devices, the transaction function devices

including a printer and an input device;

a computer in operative connection with the transaction function devices and a

memory, wherein the computer includes software executable therein, wherein the

software includes a browser;

wherein the software is operative to cause the computer to store in the memory

transaction data representative of at least one input to the input device, wherein

the software is operative to cause the browser to access a plurality of markup

language documents through a server, the plurality of markup language documents

including a first document and a second document, wherein the first document

includes at least one first print instruction and the second document includes at

least one second print instruction, and wherein the software is operative to cause

the printer to print a first item responsive to the first print instruction included in

the first document and at least a portion of the transaction data, and wherein the

software is operative to cause the printer to print a second item responsive to the

second print instruction included in the second document and at least a portion of

the transaction data.

16. The machine according to claim 15, wherein the first document includes indicia in a first language and the second document includes indicia in a second language, and wherein the first printed item includes indicia corresponding to at least a portion of the transaction data in the first language and the second printed item is includes indicia corresponding to at least a portion of the transaction data in a second language.

17. An automated banking machine including:

> a plurality of transaction function devices, the transaction function devices including a printer and an input device;

> a computer in operative connection with the transaction function devices and a memory, wherein the computer includes software executable therein, wherein the software includes a browser;

> wherein the software is operative to cause the computer to store in the memory transaction data representative of at least one input to the input device, and wherein the software is operative to cause the browser to access at least one markup language document including at least one print instruction and to operate the printer to print a check responsive to the print instruction and at least a portion of the transaction data.

18.   An automated banking machine including:

a plurality of transaction function devices, the transaction function devices
including a printer and an input device;

a computer in operative connection with the transaction function devices and a
memory, wherein the computer includes software executable therein, wherein the
software includes a browser;

wherein the software is operative to cause the computer to store in the memory
transaction data representative of at least one input to the input device, and
wherein the software is operative to cause the browser to access at least one
markup language document including at least one print instruction and to operate
the printer to print a wagering slip responsive to the print instruction and at least a
portion of the transaction data.

19.   The machine according to claim 14, wherein the at least one markup language document
includes instructions therein corresponding to a format, and wherein the item includes indicia
corresponding to at least a portion of the transaction data, which indicia is printed on the item in
accordance with the format.

20. The machine according to claim 14, wherein the transaction function devices include a cash dispenser, wherein the software is further operative to cause the cash dispenser to dispense an amount of cash.

21. Computer readable media bearing instructions which are operative to cause at least one computer in an automated banking machine to cause the automated banking machine to carry out a method comprising:

(a) conducting at least one transaction with the machine;

(b) storing transaction data corresponding to the transaction in a memory in operative connection with a computer, wherein the computer is operatively connected with the machine;

(c) accessing a first markup language document with a browser operating in the computer, wherein the first markup language document includes at least one print instruction; and

(d) printing indicia corresponding to the transaction data in the memory with a printer in the machine responsive to the print instruction included in the first document.

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22.   The computer readable media according to claim 21, wherein the instructions are further

operative to cause the at least one computer in the automated banking machine to cause the

automated banking machine to carry out a method further comprising:

e)   providing a plurality of markup language documents accessible through a server,

        the documents including the first document, and a second document wherein the

        second document includes at least one second print instruction;

f)   accessing the second markup language document with the browser;

g)   printing indicia corresponding to the transaction data in memory with the printer

        in the machine responsive to the second print instruction included in the second

        document.

23.   The computer readable media according to claim 21, wherein in step (d) the printer is

operative to print a check.

24.   The computer readable media according to claim 21, wherein in step (d) the printer is

operative to print a wagering slip.

25. A method of printing a document with an automated banking machine, comprising:

(a) conducting at least one transaction with the machine involving the dispense of cash with a cash dispenser operatively connected with the machine;

(b) storing transaction data corresponding to the transaction in a memory in operative connection with a computer, wherein the computer is operatively connected with the machine;

(c) accessing at least one markup language document, wherein the at least one markup language document includes at least one print instruction; and

(d) printing an item with indicia corresponding to at least one portion of the transaction data in the memory with a printer in the machine responsive to the print instruction included in the at least one markup language document and the transaction data stored in the memory.

26. The method according to claim 25, wherein in step (c) the at least one markup language document does not include the at least one portion of the transaction data.